

REMARKS

Claims 1-26 are pending in the application. Claims 1, 5, 8, 14, 17, and 21 are independent. By the foregoing Amendment, claims 17-26 have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 5-7 Under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected claims 5-7 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner states that the Specification fails to adequately describe an audio processor processing video packets. Applicant respectfully traverses the rejection.

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). MPEP §2163.02

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant

shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

Applicant respectfully directs the Examiner to page 7 of Applicant's Specification, which provides that "The multimedia system 100 includes an audio/video (A/V) subsystem 102 and an audio subsystem 104.... The audio/video (A/V) subsystem 102 and/or audio subsystem 104 may receive a Transport Stream (TS) 106 from any one of a variety of origins.... The Transport Stream (TS) 106 is delivered to several packet filters 110, 112, 114, and 116.... the packet filter 110 filters out all packets from the Transport Stream 106 except those that include video Packet Identifiers (video PID)." Thus Applicant respectfully submits that claims 5-7 are supported by the Specification and respectfully request that the Examiner reconsider and remove the rejection to claims 5-7.

Rejection of Claims 5-7 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 5-7 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,185,228 to Takashimizu et al. (hereinafter "*Takashimizu*"). Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 citing *Verdegaal Bros. v. Union Oil Co. of*

California, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that *Takashimizu* fails to teach the identical invention as recited in claims 5-7. For example, *Takashimizu* fails to teach “selecting **video packets that include a Program Clock Reference (PCR)** and audio transport packets from a Transport Stream; and delivering **only the selected** audio transport packets and the selected **video transport packets** to an audio processor” (emphasis added). In *Takashimizu*, all video, audio, and PCR packets are processed, not just only the video packets that have PCR and audio packets. Thus *Takashimizu* fails to anticipate claim 5 and Applicant respectfully request the Examiner reconsider and remove the rejection to claim 5 and claims 6-7 by their dependency from claim 5.

Rejection of Claims 1-4 and 8-26 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-4 and 8-26 under 35 U.S.C. §103(a) as being obvious over *Takashimizu* in view of U.S. Patent No. 5,805,602 to Cloutier et al. (hereinafter “*Cloutier*”). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143 *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain the reasoning that provides a nexus between the factual findings and the legal conclusion of obviousness. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale.

Applicants respectfully note that no matter which rationale is used, the showing of predictability and/or expectation of success is required. This long-standing principle, as outlined in MPEP§2143.02, was merely reinforced by the Court in *KSR*. “A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).”) Thus, the burden still remains on the Examiner to demonstrate each prong of the **three-part test**: (1) that each and every element is taught; (2) that one skilled in the art could have combined the references; and (3) that there is predictability/expectation of success.

As discussed above, Applicant respectfully submits that *Takashimizu* fails to teach the selecting only those video packets that have PCR packet identifiers in them and the remaining audio packets. In *Takashimizu*, all video, audio, and PCR packets are processed, not just only the video packets that have PCR and audio packets. *Cloutier* fails to make up for this deficiency. *Cloutier* does not single out video packets that contain PCR packet identifiers. This element being missing from each cited reference, the combination of *Takashimizu* in view of *Cloutier* fails render claims 1-4 and 8-26 obvious. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-4 and 8-26.

CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

/October 9, 2008/
Date

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(206) 292-8600

/Jan Little-Washington/
Jan Little-Washington
Reg. No. 41,181

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

/Kristy A. Marvel/ October 9, 2008
Kristy A. Marvel *Date*